

REMARKS

Applicants respectfully request reconsideration of the application in view of the reasons that follow.

I. Status of the Claims

Claims 1-14, 26-30, and 33-45 are pending, and claims 15-25, 31, and 32 were previously canceled. Claims 7 and 26-30 are allowed, and claims 1-6, 8-14, 33-38, and 40-45 stand rejected. Claim 39 is deemed objectionable.

II. Indication of Allowable Subject Matter

Applicants thank Examiner Bowers for indicating that 7 and 26-30 are allowed and that claim 39 would be allowed if placed into independent form including all limitations of its parent claim. However, Applicants believe that all claims are allowable in their present form, as discussed below.

III. Claims Rejections – 35 U.S.C. § 102

Claims 1, 2, 5, 6, 9, 33, 34, 37, 38 and 41 stand rejected under 35 U.S.C. 102(b) as allegedly anticipated by U.S. Patent No. 5,935,864 to Schramm. According to the Office Action, the “capillary described by Schramm is considered to be a ‘swab.’” Office Action at 14. Applicants respectfully traverse this ground of rejection.

Schramm fails to anticipate the claimed invention, because Schramm does not teach each and every element of the claimed invention. Specifically, Schramm does not teach “a swab” including both a “chamber” and “a sample tube.” Instead, Schramm discloses “a sample container” having an “open capillary end” and “an open top” with “a chamber disposed therebetween.” Schramm at col. 2, ll. 33-38. The chamber is used for analytical testing. *Id.* at col. 2, ll. 26-27. But this disclosure does not teach a swab having both “a chamber” and “a sample tube extending from an end of the chamber,” as recited by the present claims.

The Office Action equates Schramm's capillary with the "swab" recited by the present claims. However, even assuming that a "swab" were considered equivalent to a "capillary," the capillary does not have both "a chamber" and "a sample tube extending from an end of the chamber." Instead, Schramm discloses only a chamber connected to the "open capillary end." In other words, Schramm lacks a "sample tube." Indeed, "a sample tube extending from an end of the chamber" must be absent from Schramm's apparatus, because the end of Schramm's chamber opposite the capillary end is the "open top." Because the top is "open," there is no place from which "a sample tube" could extend.

The Office Action argues that, in Figures 7-9, the auxiliary container 39 is the "swab," and the sample container 37 is the "sample tube." However, the present claims recite that the swab has both "a chamber" and "a sample tube extending from an end of the chamber." In other words, the sample tube is part of the swab rather than a separate sampling component. Schramm's Figures 7-9 simply discloses two sample containers serially connected to allow two samples to be connected. Schramm's serially connected sampling containers create one large chamber. Thus, Schramm does not teach or suggest a swab having both "a chamber" and "a sample tube extending from an end of the chamber." Accordingly, Figure 7-9 of Schramm fail to teach or suggested the swab recited by the present claims.

Claim 8 is additionally distinguished from the disclosure of Schramm, because Schramm does not teach or suggest a stand "configured to attach to a slot in a hand-held detector for biological materials." Indeed, Schramm's vial 43 is used only to deliver solvent to the sample containers, and Schramm contains no suggestion that the vial 43 can be used to "engage with a hand-held detector." Thus, 46 is additionally distinguishable over Schramm.

For at least these reasons, Applicants respectfully request reconsideration and withdrawal of this ground of rejection.

IV. Claim Rejections – 35 U.S.C. § 103

A. **Schramm in view of Davis**

Claims 1, 2, 4-6, 9, 33, 34, 36-38, and 41 stand rejected under 35 U.S.C. 103(a) as allegedly obvious over Schramm in view of U.S. Published Patent Appl. No. 2005/0059165 to Davis. According to the Office Action, “it would have been obvious to exchange the capillary tube disclosed by Schramm with a more conventional swab device.” Office Action at 5. Applicants respectfully traverse this ground of rejection.

Schramm in view of Davis does not render the claimed invention obvious for at least two independent reasons. First, even if combined, the combined disclosures of Davis and Schramm fail to teach or suggest each and every element of the claimed invention. *See* MPEP § 2143 (“the prior art reference (or references when combined) must teach or suggest all the claim limitations.”). Second, one of skill in the art would have had no motivation to combine Davis and Schramm. *Id.* (“there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.”).

1. Davis Does Not Teach A “A Swab” Including Both A “Chamber” And “A Sample Tube”

Even if combined, Davis and Schramm fail to teach or suggest a swab including both a “chamber” and “a sample tube.” Davis is cited to show “that swabs (Figure 1:48) and capillary tubes (Figure 1:46) are interchangeable structures that are each fully capable of acquiring biological analytes.” Office Action at 5; *see* Davis at ¶ [0044]. However, replacing Schramm’s capillary with an absorbent material does not create a swab as recited by the present claims for the reasons discussed above in Section III. Specifically, the resulting structure would still not be a “swab” as recited by the present claims, because the swab would not have both a “chamber” and “a sample tube.” Thus, the combined disclosure of Davis and Schramm fail to teach or suggest each and every element of the claimed invention.

2. *There is no motivation to combine Davis with Schramm*

“If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” MPEP § 2143.01 (citations omitted). Here, the modification of Schramm suggested by the Office Action would modify the Schramm’s principle of operation. Specifically, in contrast to the present invention Schramm is entirely directed to using capillary action. *See, e.g.*, Schramm at Summary of the Invention; col. 3, ll. 24-59. Thus, “the teachings of the references are not sufficient to render the claims *prima facie* obvious.” MPEP § 2143.01.

Moreover, Schramm explicitly teaches away from the use of an absorbent material. Specifically, in the Background of the Invention section of Schramm, the limitations of absorbent materials are listed. Schramm at col. 1, l. 48 – col. 2, l. 3. In view of the limitations of absorbent materials, Schramm provides an apparatus using a capillary rather than an absorbent material. *See* Schramm at Summary of the Invention. Thus, Schramm specifically teaches away from the suggested modification. Because “[i]t is improper to combine references where the references teach away from their combination,” it is not proper to combine Schramm and Davis as suggested. MPEP § 2145(X)(D)(2).

B. Rejection of Dependent Claims

The Office Action sets forth the following grounds of rejection:

- (a) Claims 3 and 35 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Schramm and Davis as applied to claims 1 and 33, and further in view of U.S. Patent No. 6,634,243 to Wickstead.
- (b) Claims 8, 10, 40, and 42 stand rejected under 35 U.S.C. 103(a) as allegedly obvious over Schramm and Davis as applied to claims 1 and 33, and further in view of U.S. Published Patent Appl. No. 2002/0001539 to DiCesare;

- (c) Claims 11 and 43 stand rejected under 35 U.S.C. 103(a) as allegedly obvious over Schramm, Davis, and DiCesare as applied to claims 10 and 42, and further in view of U.S. Patent No. 4,562,043 to Mennen;
- (d) Claims 12, 13, 44 and 45 stand rejected under 35 U.S.C. 103(a) as allegedly obvious over Schramm in view of Davis and DiCesare as applied to claims 10 and 42, and further in view of U.S. Patent No. 5,084,045 to Berke; and
- (e) Claim 14 stands rejected under 35 U.S.C. 103(a) as allegedly obvious over Schramm in view of Davis and DiCesare as applied to claim 10, and further in view of U.S. Published Patent Appl. No. 2003/0113906 to Sangha.

These grounds of rejection are all directed to dependent claims and rely on the combination of Schramm in Davis further in view of one or more additional references to teach the features of the dependent claims. As discussed above in Section IV(A), the combined teachings of Schramm and Davis fail to render the independent claims obvious., The additional references used to make rejections (a)-(e) do not remedy these deficiencies. Thus, these grounds of rejection should be withdrawn for the same reasons discussed for the rejection based on Schramm in combination with Davis, above.

For at least this reasons, Applicants respectfully request withdrawal of rejections (a)-(e).

V. Double Patenting

Claims 1, 2, 5, 9, 10, 12, 25, 27, 29 and 32 are rejected under the judicially created doctrine of obviousness-type double patenting in view of co-pending Patent Application No. 10/852,684.

The '684 application has not yet issued as a patent. If it issues as a patent, Applicants will address the rejection. If the double patenting rejection is the only rejection remaining, Applicants respectfully request that it be withdrawn according to MPEP § 804(I.B).

Conclusion

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

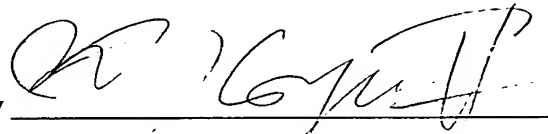
Examiner Bowers is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

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